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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,692	01/30/2001	Madoka Mitsuoka	1405.1035 (JDH)	8152

21171 7590 09/23/2004

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WASHINGTON, DC 20005

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,692

Applicant(s)

MITSUOKA ET AL.

Examiner

John L Young

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

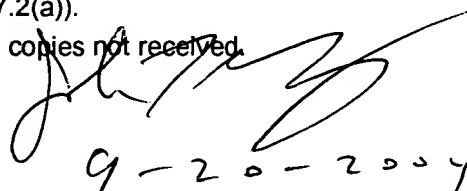
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER



9-20-2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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SECOND ACTION REJECTION

(Paper# 9/20/2004)

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

2. **Rejections Withdrawn.**

CLAIM REJECTIONS — 35 U.S.C. §103(a)

3. **Rejections Maintained.**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-17 are rejected under 35 U.S.C. §103(a) as being obvious over Horstmann 6,285,985 (9/4/2001) [US f/d: 4/3/1998] (herein referred to as "Horstmann").

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As per independent claim 1, Horstmann (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) implicitly shows all the elements and limitations of claim 1.

Horstmann lacks explicit recitation of the phrase “awareness device”; however,

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstmann (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) implicitly shows an “awareness device. . . .” and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing an “awareness device. . . .”, because modification and interpretation of the cited disclosure of Horstmann would have provided means “*to retrieve advertisements from an advertisement server and to display them to the user. . . .*” (see Horstmann (col. 2, ll. 5-10), based on the motivation to modify Horstmann of “*allowing advertisements to be targeted to the user.*” (See Horstmann (col. 2, ll. 1-35).

As per dependent claims 2-11, Horstmann shows the method of claim 1.

of Horstmann (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) implicitly shows all of the elements and limitations of claims 2-11; however,

Horstmann lacks explicit recitation of some of the elements and limitations of claims 2-11.

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“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 2-11, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Horstmann cited above as showing all of the elements and limitations of claims 2-11, because modification and interpretation of the cited disclosure of Horstmann would have provided means “*to retrieve advertisements from an advertisement server and to display them to the user. . . .*” (see Horstmann (col. 2, ll. 5-10), based on the motivation to modify Horstmann of “*allowing advertisements to be targeted to the user.*” (See Horstmann (col. 2, ll. 1-35).

Independent claim 12 is rejected for substantially the same reasons as independent claim 1.

Independent claim 13 is rejected for substantially the same reasons as independent claim 1.

As per independent claim 14, Horstmann (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) implicitly shows all the elements and limitations of claim 14.

Horstmann lacks explicit recitation of the phrase “awareness service”; however,

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It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstmann (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) implicitly shows an “awareness service. . . .” and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing an “awareness service. . . .”, because modification and interpretation of the cited disclosure of Horstmann would have provided means “*to retrieve advertisements from an advertisement server and to display them to the user. . . .*” (see Horstmann (col. 2, ll. 5-10), based on the motivation to modify Horstmann of “*allowing advertisements to be targeted to the user.*” (See Horstmann (col. 2, ll. 1-35).

Independent claim 15 is rejected for substantially the same reasons as independent claim 14.

Independent claim 16 is rejected for substantially the same reasons as independent claim 15.

As per independent claim 17, Horstmann (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) implicitly shows all the elements and limitations of claim 17.

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Horstmann lacks explicit recitation of the phrase an “awareness device”;
however,

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstmann (the ABSTRACT; FIG. 1; FIG. 4; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and col. 5, ll. 1-23) implicitly shows an “awareness device. . . .” and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing an “awareness device. . . .”, because modification and interpretation of the cited disclosure of Horstmann would have provided means “*to retrieve advertisements from an advertisement server and to display them to the user. . . .*” (see Horstmann (col. 2, ll. 5-10), based on the motivation to modify Horstmann of “*allowing advertisements to be targeted to the user.*” (See Horstmann (col. 2, ll. 1-35).

RESPONSE TO ARGUMENTS

5. Applicant's arguments (Amendment paper# 6/21/2004) have been fully considered but they are not persuasive for the following reasons:

Applicant's arguments are moot based on new grounds of rejection introduced by the Examiner in the instant Office action.

CONCLUSION

6. Any response to this action should be mailed to:

Serial Number: 09/771,692

(Mitsuoka et al.)

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

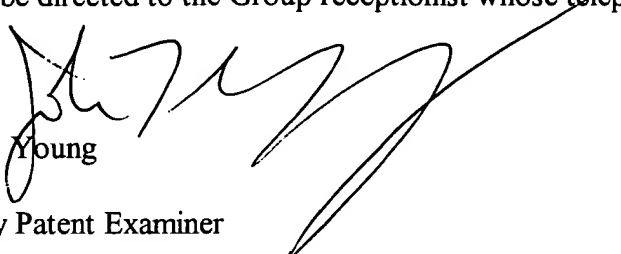
Serial Number: 09/771,692

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

September 20, 2004